

REMARKS

Response to Claim Objections

Examiner objected to Claims 3-4, stating they were duplicates of Claims 1-2. Claims 3-4 are not duplicates of Claims 1-2 as Examiner has stated. Claims 3-4 provide an alternative method of creating perfumed socks. Claims 1-2 provide a method where yarn is first dyed and soaked in fragrance before it is formed into socks. Conversely, Claims 3-4 provide a method wherein the yarn is formed in to socks before it is dyed and dipped in fragrance. These two methods, while similar, provide different methods of reaching the same end product. Therefore, Applicant respectfully requests that Claims 1-4 be allowed as distinct claims.

35 U.S.C. § 103

Claims 1-5 are rejected over Ono in view of Taniguchi.

Examiner had rejected Claims 1-5 under 35 U.S.C.103 as being unpatentable over Ono et al. (US 4,917,920) in view of Taniguichi et al. (JP 404,082,955 A).

In order to establish a *prima facie* case of obviousness under 35 U.S.C. § 103, the examiner must demonstrate that there is a suggestion or motivation, either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art, to modify the references or combine the reference teachings. Furthermore, the prior art references must teach or suggest all of the claimed features. It is well settled law that the prior art itself must provide the

motivation for a proposed alteration of a reference. Ex parte Chicago Rawhide Manufacturing Co., 220 U.S.P.Q. 351, (B.O.P.A. 1984). Moreover, the suggestion must be plain and clear or the rejection is untenable. Fromson v. Offset Plate, Inc., 225 U.S.P.Q. 26, 32 (Fed. Cir. 1985); Kimberly-Clark Corp. v. Johnson & Johnson, 223 U.S.P.Q. 603, 610 (Fed. Cir. 1984). The Examiner is not free to pick bits and pieces from the prior art and, with the hindsight benefit of applicants' disclosure, attempt to reconstruct the invention. Orthopedic Equipment, Inc. v. U.S., 217 U.S.P.Q. 193, 199, (Fed. Cir. 1983).

An invention is often the product of devices that preceded it. It is truly a rare invention that does not incorporate any existing technology in its components. If all of the elements of applicant's invention were disclosed by two references, and only a minor borrowing of elements between the two references is necessary to achieve applicant's invention, then this would be a strong case of obviousness. In rejecting claims 1-5, however, Examiner has combined diverse elements of two inventions with different purposes which differ significantly from applicant's invention. As stated earlier, Examiner is not free to pick bits and pieces from the prior art and, with the hindsight benefit of the applicant's disclosure, attempt to reconstruct the invention. Orthopedic Equipment, Inc. v. U.S., 217 U.S.P.Q. 193, 199, (Fed. Cir. 1983). Yet, in combining these two references to form the present invention, this is precisely what Examiner is doing. The present invention is a significant departure from the references cited by the Examiner.


Examiner is respectfully requested to reconsider the rejection of claims 1-5 under 35 U.S.C. § 103 in light of the amendments to the claims and the foregoing comments.

CONCLUSION

In view of the foregoing amendment and remarks, it is believed that this Application is now in condition for allowance. Early and favorable reconsideration is respectfully solicited.

If the Examiner has any questions regarding the foregoing amendment and remarks, or if prosecution of this Application could be furthered by a telephone interview, the Examiner is requested to telephone the Applicant's undersigned attorney.

Respectfully submitted,

By: 
SCOTT J. FIELDS
Reg. No. 32,857

Date: December 21, 2006

NATIONAL IP RIGHTS CENTER, LLC
550 TOWNSHIP LINE RD.
SUITE 400
BLUE BELL, PA 19422
(610)-680-2301



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Non-provisional patent application of

Hyo G. Lee

Group Art Unit: 1751

Application No: 10/782,531

Examiner Name: Preeti Kumar

For: METHOD OF MAKING PERFUMED SOCKS

Filing Date: February 2, 2004

Mailing Date of

Office Action: September 21, 2006

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Mail Stop Response

Date of Deposit: December 21, 2006

I hereby certify that this Response to Office Action and fee are being deposited with the United States Postal Service via First Class Mail on the date indicated above, addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, Mail Stop Response.

SCOTT J. FIELDS

Date: December 21, 2006

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550 TOWNSHIP LINE RD.

SUITE 400

BLUE BELL, PA 19422

(610)-680-2301